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| EXAMINER |
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WORJLOH, JALATEE

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| ART UNIT | PAPER NUMBER |
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3621

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03/04/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/651,030 | Applicant(s) SUKEDA ET AL. | |
| | Examiner Jalatee Worjloh | Art Unit 3621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed December 11, 2007. Claims 1-12 were canceled. Claims 13-18 are pending.

Response to Arguments

2. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. Claims 13-18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Claims 13-15 are not sufficiently precise due to the combining of two separate statutory classes of invention in a single claim. The preamble of the claims refers to a server, but the body of the claims discusses the specifics of both a server and a method (i.e. various components of the server and several steps (e.g. outputting, updating)).
5. Claims 16 and 17 are not sufficiently precise due to the combining of two separate statutory classes of invention in a single claim. The preamble of the claims refers to an apparatus, but the body of the claims discusses the specifics of both a server and a method (i.e. various components of the server and several steps (e.g. outputting, storing)).
6. Claim 18 is rejected as it depends on claim 16 above.

Claim Objections

7. Claim 15 is objected to because of the following informalities: Claim 15 is a duplicate of claim 14; please delete one of the claims. Appropriate correction is required.

Claim 17 is objected to because of the following informalities: Claim 17 is a duplicate of claim 16. Appropriate correction is required.

8. Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 17 is a duplicate of claim 16.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 13-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

11. 35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, *or* composition of matter, *or* any new and useful improvement thereof" (emphasis added). The applicants claims mentioned above are intended to embrace or overlap *two* different statutory classes of invention as set forth in 35 USC 101. The claims begin by discussing a server, but subsequently the claims then deal with the specifics of a method (the steps) executed by the point management program stored on the terminal (see above rejection of claims under 35 USC 112, second paragraph, for specific details regarding this issue). "A claim of this type is precluded by the express language of 35 USC 101 which is drafted so as to set forth the statutory classes of invention in the alternative only", Ex parte Lyell (17 USPQ2d 1548).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 13 – 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6014634 to Scroggie et al. (“Scroggie”) in view US Patent No. 6409080 to Kawagishi.

Referring to claim 13, Scroggie discloses a control unit, a communication unit for carrying out communication with the network, and the control unit generates a customer ID according to a request from a user at a computer and sends to a computer a point management program (i.e. purchasing incentive) with the generated customer ID incorporated therein (see col. 1, lines 65-67; col. 2, lines 1-7; col. 3, lines 25-32; fig. 13 –fig. 14). Scroggie does not expressly disclose a portable terminal comprising a data input unit for inputting data, a data output unit for outputting data, a storage unit for recording customer ID data and point data and a program execution unit, wherein the point management program executes steps including outputting the recorded customer ID data through the data output unit, receiving customer ID data and point data through the data input unit, comparing the received customer ID data with the recorded customer ID, updating the recorded point data using the received point data when a customer ID in the received customer ID data is authenticated, and storing the updating point data including the customer ID in the data storage unit. Kawagishi discloses a portable terminal comprising a data input unit for inputting data, a data output unit for outputting data (see col. 2,

Art Unit: 3621

lines 15-30), a storage unit for recording customer ID data and point data (see col. 3, lines 66,67; col. 4, lines 1-9) and a program execution unit (see col. 3, lines 24-30), wherein the point management program executes steps including outputting the recorded customer ID data through the data output unit (see col. 5, lines 35-40), receiving customer ID data and point data through the data input unit (see col. 5, lines 13-16), comparing the received customer ID data with the recorded customer ID (see col. 6, lines 4-16), updating the recorded point data using the received point data when a customer ID in the received customer ID data is authenticated, and storing the updating point data including the customer ID in the data storage unit (see col. 5, lines 17-34).

At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the server disclose by Scroggie to include a portable terminal comprising a data input unit for inputting data, a data output unit for outputting data, a storage unit for recording customer ID data and point data and a program execution unit, wherein the point management program executes steps including outputting the recorded customer ID data through the data output unit, receiving customer ID data and point data through the data input unit, comparing the received customer ID data with the recorded customer ID, updating the recorded point data using the received point data when a customer ID in the received customer ID data is authenticated, and storing the updating point data including the customer ID in the data storage unit. One of ordinary skill in the art would have been motivated to do this because it provides a portable electronic device and a loyalty point system capable of calculating loyalty points corresponding to individual information while keeping the security (see col. 1, lines 66, 67 & col. 2, lines 1, 2).

Referring to claim 14, Scroggie discloses the server and the elements of claim 13.

Scroggie does not expressly disclose wherein the data storage unit stores unit history data and a

Art Unit: 3621

current result of customer information analysis and wherein the point management program further executes steps including: outputting the stored result of the customer information analysis as well through the data output unit, conducting customer information analysis using the received point data when the customer ID is authenticated and storing the result of the customer information analysis in the data storage unit wherein the customer ID data and the point data input through the data output unit are encrypted and wherein the point management program further executes step including: deciphering the encrypted customer ID data and the encrypted point data and then performing the authentication. Kawagishi discloses the missing elements (see claim 13 citations above and col. 3, lines 35-41- the customer purchase and loyalty information is stored; the Examiner interprets the previously stored loyalty information as history data). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the server disclose by Scroggie to include wherein the data storage unit stores unit history data and a current result of customer information analysis and wherein the point management program further executes steps including: outputting the stored result of the customer information analysis as well through the data output unit, conducting customer information analysis using the received point data when the customer ID is authenticated and storing the result of the customer information analysis in the data storage unit wherein the customer ID data and the point data input through the data output unit are encrypted and wherein the point management program further executes step including: deciphering the encrypted customer ID data and the encrypted point data and then performing the authentication. One of ordinary skill in the art would have been motivated to do this because it provides a portable

Art Unit: 3621

electronic device and a loyalty point system capable of calculating loyalty points corresponding to individual information while keeping the security (see col. 1, lines 66, 67 & col. 2, lines 1, 2).

Claim 15 is rejected on the same rationale as claim 14 above.

Referring to claim 16, Scroggie discloses a control unit, a communication unit for carrying out communication with the network wherein the control unit generates a customer ID according to a request from the portable terminal, and sends to the computer a point management program (i.e. purchasing incentive) with the generated customer ID incorporated therein (col. 1, lines 65-67; col. 2, lines 1-7; col. 3, lines 25-32; fig. 13 & fig. 14) Scroggie does not expressly disclose a portable terminal wherein the portable terminal comprising a data input unit for inputting data, a data output unit for inputting data, a data output unit for outputting data, a data storage unit for recording customer ID data and point data, and a program execution unit, wherein the point management program executes steps including acquiring customer ID data output from an output unit of the portable terminal through the data input unit, generating output data including input data and the customer ID data and outputting the output data through the data output unit, wherein the point management program further executes steps including outputting the stored result of the customer information analysis as well through the data output unit, conducting customer information analysis using the received point data when the customer ID is authenticated and storing the result of the customer information analysis in the data storage unit. Kawagishi a portable terminal wherein the portable terminal comprising a data input unit for inputting data, a data output unit for inputting data, a data output unit for outputting data, a data storage unit for recording customer ID data and point data, and a program execution unit, wherein the point management program executes steps including acquiring customer ID data

Art Unit: 3621

output from an output unit of the portable terminal through the data input unit, generating output data including input data and the customer ID data and outputting the output data through the data output unit, wherein the point management program further executes steps including outputting the stored result of the customer information analysis as well through the data output unit, conducting customer information analysis using the received point data when the customer ID is authenticated and storing the result of the customer information analysis in the data storage unit (see claims 13 & 14 citations above). At the time the invention was made it would have been obvious to one of ordinary skill in the art to modify the server disclose by Scroggie to include a portable terminal. One of ordinary skill in the art would have been motivated to do this because it provides a portable electronic device and a loyalty point system capable of calculating loyalty points corresponding to individual information while keeping the security (see col. 1, lines 66, 67 & col. 2, lines 1, 2).

Claim 17 is rejected on the same rationale as claim 16 above.

Referring to claim 18, Scroggie discloses the apparatus, wherein the output data is encrypted as an arrangement of numbers and is printed on paper (see fig. 1; col. 2, lines 65-67 – encoded incentive/the token, which is known to be encrypted).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

Art Unit: 3621

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjloh/
Primary Examiner, Art Unit 3621

Application/Control Number: 10/651,030
Art Unit: 3621

Page 10

February 23, 2008